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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,883	06/07/2001	Ryoichi Nemori	Q63526	6523

7590 10/17/2002
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EXAMINER

GITOMER, RALPH J

ART UNIT PAPER NUMBER

1651

DATE MAILED: 10/17/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,883

Applicant(s)

Nemori et al.

Examiner

Ralph Gitomer

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 8, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10 6) ☐ Other: _____

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The amendment and IDS received 7/8/02 have been entered. No references were found with the IDS, new copies of those listed on the form 1449 have been included in this communication.

5 In view of the amendments to the claims, the objection under 37 CFR 1.75(c) is hereby withdrawn.

The rejection of record of claims 9-13 under 35 U.S.C. 102(b) over Ikeda is maintained.

10 Applicant's arguments filed 7/8/02 have been fully considered but they are not persuasive.

Applicants argue that Ikeda's film is opaque.

15 It is the examiner's position that the claims do not distinguish the films taught by Ikeda. No degree of transparency is claimed.

The rejection of record of claims 1-13 under 35 U.S.C. 103(a) over Holger in view of Kerschensteiner is maintained.

20 Applicant's arguments filed 7/8/02 have been fully considered but they are not persuasive.

Applicants argue that iron ions are essential in the process of Holger whereas in the present invention a metal or metal compound which is hardly ionizable is used and no ligand is applied. A soluble particle cannot be used in the present invention. Further, Holger uses a reduction process. The present invention provides convenient handling of the membrane. Regarding Kerschensteiner, larger aggregated particles are formed on the basis of freely movable particles whereas the present invention encloses the particles in a matrix. Further, Kerschensteiner uses larger samples than the present invention. The membrane of the present invention is more stable than that of Kerschensteiner.

It is the examiner's position that no degree of ionizability is claimed and the claims as written encompass the metal or metal compounds taught by Holger. The present claims do not exclude a reduction process. Undisclosed advantages are given little or no weight. Kerschensteiner was cited to teach colloidal metal particles. No sample sizes or membrane stability is claimed.

It is respectfully submitted that in order for evidence of unexpected results to be sufficient to rebut a prima facie case of obviousness, the evidence must be commensurate in scope with the claims.

The following prior art pertinent to applicant's disclosure is made of record and not relied upon:

Terumo (JP 5-130897) teaches determining thiol compounds.

Terumo (JP 6-16619) teaches determining thiol compounds.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the
15 statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (703) 308-0732. The examiner can normally be reached on Tuesday-Friday from 8:00 am - 5:00 pm.
25 The examiner can also be reached on alternate Mondays. If

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attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Michael Wityshyn can be reached on (703)
308-4743. The fax phone number for this Art Unit is (703) 308-
4556. Any inquiry of a general nature or relating to the status
5 of this application should be directed to the Group receptionist
whose telephone number is (703) 308-1235. For 24 hour access to
patent application information 7 days per week, or for filing
applications electronically, please visit our website at
www.uspto.gov and click on the button Patent Electronic Business
10 Center for more information.


Ralph Gitomer
Primary Examiner
Group 1651

RALPH GITOMER
PRIMARY EXAMINER
GROUP 1200